

Application No. 10/717,434
Response to Final Office Action
Page -13-

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JAN 18 2007

58404(50533)

REMARKS

Claims 43, 48-49, 53, and 63-66 have been amended. Claims 82 to 96 have been added. Claims 44-46, 52, and 54 have been cancelled. No new matter is added by virtue of the within amendments; support therefore can be found throughout the specification and in the original claims of the application. For instance, support for the amendments and newly presented claims can be found at least at page 5, line 15 through page 6, lines 10-28 and line 28, page 10, lines 15-16, and in original claim 47.

As an initial matter, Applicant thanks the Examiner for her time and courtesy during the telephonic interview conducted on January 4, 2007.

Claims 44-46 and 53-55 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

It is believed that the within amendments overcome the objection. For instance, claim 45 has been rewritten as independent claim 94. The dependency of claim 53 has been amended to now depend on claim 94. Claims 44, 46, 52 and 54 have been cancelled. Support for 2'-deoxy pentofuranose sugar moiety containing nucleotides, such as DNA, in B can be found throughout the specification, for example at page 6, lines 12-13. Withdrawal of the objection is requested.

The prior art rejections are summarized as follow:

Claims 43-46, 51-54 and 59-62 are rejected under 35 USC 102(b) over Wahlestedt et al. (WO 01/25248); and

Claims 43-81 are rejected under 35 USC 103(a) over Wahlestedt et al. (WO 01/25248).

Application No. 10/717,434
Response to Final Office Action
Page -14-

58404(50533)

The rejections are respectfully traversed. The cited references do not teach or suggest the present invention in any manner sufficient to sustain the instant rejections. Nonetheless, the claims of the application have been amended to further define and clarify the features of the invention.

Currently amended claim 43 recites:

An oligonucleotide which has the formula (in 5' to 3' order): A-B-C-D, in which
A represents a sequence of locked nucleotide units;
B represents a sequence of non-locked nucleotide units, wherein B has a length
of 4-20 nucleotide units;
C represents a sequence of locked nucleotide units; and
D represents a non-locked nucleotide unit or a sequence of non-locked
nucleotide units.

Further to Applicant's discussion with the Examiner, in the motif of Wahlestedt et al., 5'-[X_mY_nX_p]q-3', wherein Y_n denotes the number of non-oxy-LNA monomers in the formula. Wahlestedt et al. define "n as an integer from 0 to 3" (see page 8, lines 20-23).

In contrast to Wahlestedt et al., independent claim 43 of the present invention has been amended to recite that B has a length of 4-20 nucleotide units. Applicant submits that the claim limitations of the currently amended claim 43 do not overlap with the teachings of the cited art. Therefore, the claim cannot be anticipated by that art. Moreover, claim 43 is not obvious in view of the cited art. The several remaining claims that are dependent either directly or indirectly on independent claim 43, also are neither anticipated nor obvious over Wahlestedt et al. Likewise, new claim 83 recites the same distinctive feature wherein "B has a length of 4-20 nucleotide units." Thus, that claim also avoids the cited art.

Accordingly, withdrawal of the §102 rejection is respectfully requested. [See *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978) ("[r]ejections under 35 U.S.C. §102 are

Application No. 10/717,434
Response to Final Office Action
Page -15-

58404(50533)

proper only when the claimed subject matter is identically disclosed or described in the prior art."])

Additionally, it is well-known that to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference(s) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143.

There is no suggestion or motivation, either in the art cited or in the knowledge generally available to one of ordinary skill in the art, to modify the cited reference to make the claimed invention, nor is there a reasonable expectation of success.

In view thereof, reconsideration and withdrawal of the §103 rejection are requested.

All of the newly added claims are dependent either directly or indirectly on claim 43, or contain all of the elements of claim 43 which is both novel and non-obvious in view of the cited art for the reasons set forth above. Therefore, the newly added claims are allowable in view of the cited art.

RECEIVED
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Page -13-

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Application No. 10/717,434
Response to Final Office Action
Page -14-

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Application No. 10/717,434
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Page -15-

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Application No. 10/717,434
Response to Final Office Action
Page -16-

58404(50533)

In view of the above amendments and remarks, Applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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